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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOHN R. STEFANIK and ROBERT A. KOCH

Appeal 2016-003212
Application 14/104,024
Technology Center 2400

Before ELENI MANTIS MERCADER, CARL W. WHITEHEAD JR., and ADAM J. PYONIN, *Administrative Patent Judges*.

PER CURIAM.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Final Rejection of claims 1–20. Appeal Brief 1. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM and enter NEW GROUNDS OF REJECTION pursuant to 37 C.F.R. § 41.50(b).

Introduction

Appellants' invention relates to "target[ing] content to a device" in which "[r]ecently entered commands entered at the device are associated to an advertisement." Abstract.

Representative Claim (Disputed limitations emphasized)

1. A method, comprising:
receiving, at a server, an upload of commands associated with a device;
receiving, at the server, additional commands associated with the device entered since receipt of the upload of commands;
associating only the additional commands to an advertisement;
retrieving the advertisement; and
sending the advertisement to the device.

Rejection on Appeal

Claims 1–20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hendricks (US Patent Number 6,738,978 B1,issued May 18, 2004) in view of Herz (US Patent Application Publication Number 2006/0161952 A1, published July 20, 2006). Final Rejection 3.

ANALYSIS

Rather than reiterate the arguments of Appellants and the Examiner, we refer to the Final Rejection (mailed December 23, 2014), the Appeal Brief (filed June 15, 2015), the Answer (mailed November 30, 2015), and the Reply Brief (filed January 29, 2016) for the respective details. We have considered in this decision only arguments Appellants actually raised in the Briefs.

We have reviewed the Examiner's rejections in light of Appellants' arguments that the Examiner has erred. We adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in the

Examiner's Answer in response to Appellants' Appeal Brief, except where noted.

Claim 1

Appellants argue Examiner error because "when Hendricks with Herz's paragraph [0312] is scrutinized, the textual evidence clearly states that advertisements are targeted "based on historical viewing data"' (Appeal Brief 8) and the cited portion of Herz "explains how the 'customer profile' may be updated with purchases and watched infomercials." Appeal Brief 10. Appellants make similar arguments regarding the other paragraphs of Herz cited by the Examiner, and state repeatedly that "the proposed combination of Hendricks with Herz thus teaches nothing fairly equivalent to targeting advertisements based on 'only the additional commands' that have been entered 'since receipt of the [previous] upload of commands,' as independent claim 1 recites. Appeal Brief 11–16; *see*, for example, Appeal Brief 11 regarding Herz ¶ 281.

We are not persuaded by Appellants' arguments. The Examiner finds that "Herz teaches . . . the agreement matrix may be updated based on feedback [. . .] the agreement matrix can also be used to select infomercials or other advertisements that the customer is most likely to watch." Final Rejection 4, citing Herz ¶ 281. The Examiner additionally finds that "[b]ased on the applicant's explanation regarding targeted advertisement[,]'only the additional commands' is understood to be an update of the customer profile" (Final Rejection 2) and "[t]his is exactly what Herz is teaching" (Final Rejection 2, citing Herz ¶ 312).

Appellants' arguments regarding "targeted advertisements" are not commensurate with the scope of the claim, which requires "associating only

the additional commands to an advertisement." Such an association is disclosed or suggested by the combination of Hendrick and Herz, in which the commands that comprise customers' "viewing habit data" and the "record of what customers desire to watch and what they actually watched" (Herz ¶ 281) made "when shopping at home, using infomercials, as when watching a movie" (Herz ¶ 312) are associated only to "select infomercials or other advertisements." Herz ¶ 312. That Herz's "agreement matrix" may contain historical data (*see* Herz ¶ 312) does not negate an association between the additional customer commands corresponding to the viewing habit data and the advertisement. The disputed limitation, "associating only the additional commands to an advertisement," is broader than determining the advertisement based only on the additional commands, which appears to be Appellants' argued construction. We further note that Appellants' interpretation of "associating only" does not appear supported by the Specification.[1]

Accordingly, we sustain the Examiner's rejection of independent claim 1, and independent claims 8 and 15 commensurate in scope, and claims 4–7, 11–14, and 18–20 not separately argued. *See* Appeal Brief 17–18.

Claims 2, 3, 9, 10, 16, and 17

Appellants argue Examiner error because the combination of Hendricks and Herz do not teach or suggest "assigning a demographic to the

[1] For further explanation, see below at the section titled "NEW GROUNDS OF REJECTION."

additional commands," as recited in claims 2, 9, and 16. Appeal Brief 19. Appellants similarly argue Examiner error because the combination of Hendricks and Herz do not teach or suggest "assigning a profile to the additional commands," as recited in claims 3, 10, 17. Appeal Brief 19–20. For all the dependent claims at issue, Appellants contend "[t]he proposed combination of Hendricks with Herz would somehow 'average' the 'additional commands' into an existing long term historical profile." Appeal Brief 19, 20.

We are not persuaded by Appellants' arguments, which require the verb "assigning" to be narrowly interpreted, similar to the narrow interpretation of the verb "associating" that Appellants argued with respect to claim 1. Similar to the above analysis, we follow the broadest reasonable interpretation standard.

Accordingly, we sustain the Examiner's rejection of claims 2, 3, 9, 10, 16, and 17.

NEW GROUNDS OF REJECTION

Pursuant to our authority under 37 C.F.R. § 41.50(b), we enter new grounds of rejection and separately reject claims 1–20 under pre-AIA 35 U.S.C. § 112, first and second paragraphs.

The Examiner finds that "the statement 'associating only the additional commands to an advertisement' is found nowhere in the specs, as stated in the office action dated 12/29/2014." Answer 2. Although the Examiner did not make a written description rejection, Appellants argue "[t]he association between an advertisement and only the 'additional

commands' is discussed at least at page 15, last paragraph and at page 17, last full paragraph." Appeal Brief 5; *see* Reply Brief 3–4.

We note the cited portion of the Specification states that "[i]n this manner, profile processor 100 has the latest event data, along with the data from other databases, to assess a viewer's current interests" (Spec. 15:25–27), suggesting that more than commands, such as "data from other databases," are used to "target[] a specific customer profile" (Spec. 15:29). The cited portion also states that "profile processor 104 . . . can use the latest available event data of the subscriber to deliver advertisements" (Spec 17:25–26), but does not indicate either the type of association or an exclusivity of the latest event data used in the delivery of advertisements.

Accordingly, we do not find support in the written description for the limitation "associating only the additional commands to an advertisement" appearing in independent claims 1, 8, and 15. Because of the apparent ambiguity of the term "associating only" appearing in the independent claims when compared to Appellants' remarks, we similarly find independent claims 1, 8, and 15 indefinite. *See In re Packard*, 751 F.3d 1307, 1311 (Fed. Cir. 2014).

DECISION

We affirm the Examiner's rejection of claims 1–20.

We newly reject claims 1, 8, and 15 under 35 U.S.C. § 112, first and second paragraphs.

37 C.F.R. § 41.50(b) provides a "new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . . .
>
> (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record . . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv). *See* 37 C.F.R. § 41.50(f).

AFFIRMED;

37 C.F.R. § 41.50(b)